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| 10/047,018 | 01/15/2002 | William Kress Bodin | AUS920010853US1 | 5704 |
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| INTERNATIONAL CORP (BLF) c/o BIGGERS & OHANIAN, LLP P.O. BOX 1469 AUSTIN, TX 78767-1469 | | | EXAMINER DENNISON, JERRY B | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/047,018 | Applicant(s) BODIN ET AL. | |
| | Examiner J. Bret Dennison | Art Unit 2443 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to the Amendment for Application Number 10/047,018 received on 8/18/2008.
2. Claims 1-21 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 1, 8, and 15 recite the limitation, "the email display capability status attributes" in the last limitation of each claim. There is insufficient antecedent basis for this limitation in the claim.
5. Claims 1, 8, and 15 recite the limitation, "an availability field, wherein the availability field is a status indication of whether a display capability is currently available to receive email..." It is unclear to Examiner what is meant by a display capability being available to receive email, as it is a capability, and not for example, an email account or a device.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-8, 11-15 & 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. (U.S. Patent Number 6,092,114) in view of Baudoin (US 5406557), and in further view of Wakabayashi (US 20020120699) and Albal et al. (US 6725256).

3. Regarding Claims 1, 8 & 15, Shaffer discloses a system, method and computer program for email administration comprising the steps of:

- receiving in a transcoding gateway from a client device one or more email display status attributes describing one or more email display capability statuses for a domain, (Col. 2, lines 30-65 & Col. 6, lines 31-53);
- receiving in the transcoding gateway from a sender an email display capability status request for the domain, wherein the capability status request comprises a domain identification, (Col. 6, lines 6-67 & Col. 7, lines 1-38), (Examiner notes that Shaffer discloses a message sent by a sender to the server where a determination is made based on client capabilities, wherein said message would obviously be a default means of requesting capability status, especially in light of the fact that Shaffer

discloses a capability status determination, a conversion means, and a notification to sender means, all related to the ability of the client/target device to receive the sender's message, and wherein the sender is notified of a client's inability to receive the message based on conversion requirements, which requirements are obviously an indication of the client/domain ability/capability to receive the sender's message.

Additionally, the motivation to request client capability is also found within Shaffer which teaches the need for files to be accessible to the client device as well as a conversion consideration, wherein both conversion time and data loss are important access file/sharing issues, (Col. 1, lines 55-67 & Col. 2, lines 1-27));

- finding, in dependence upon the domain identification, at least one email display capability status record for the domain (Shafer, col. 6, lines 30-40, access capabilities of the target client are determined, using a lookup table), wherein the email display capability status record for the domain includes:

a display capability identification (col. 6, lines 42-43, 54-55 "access capabilities" which indicate characteristics of the condition of the client devices that identify if the client have the capability to access or display an attachment For further explanation, see BPAI Decision, filed 6/16/08, page 5, second paragraph);

a display capability description (col. 6, lines 42-43, 54-55 "access capabilities" which indicate characteristics of the condition of the client devices that identify if the client have the capability to access or display an attachment For further explanation, see BPAI Decision, filed 6/16/08, page 5, second paragraph; such indication of the characteristics clearly describe the capability);

a connection address, wherein the connection address is an indication of where to send email or digital objects from the transcoding gateway (Shafer, col. 2, lines 45-55, the lookup table must include each receiving user's email address associated with the user's client device in order to make such a correspondence and determination of the client's capabilities to that of the email message received);

a transcode type, wherein the transcode type is an indication whether digital objects in email are to be transcoded in the transcoding gateway or forwarded for further processing elsewhere (Shafer, col. 7, lines 1-25, Shafer disclosed making the determination as to whether the conversion can be performed locally or if should be performed remotely, based on the client capabilities within the lookup table); and

- sending at least one of the email display capability status attributes to the sender, (Col. 6, lines 6-67 & Col. 7, lines 1-38), (Examiner notes that Shaffer teaches sender notification concerning conversion requirements,

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which conversion requirement obviously represent client/target display capability status attributes).

Shafer did not explicitly state wherein the record includes a connection type, wherein the connection type is an indication of the protocol or communications technology to be used to send an email or digital objects to client devices;

In an analogous art, Baudoin disclosed an electronic communication center that stores user-specific protocols based on the user's email address to ensure that user's receive email in the appropriate protocol (Baudoin, col. 2, lines 1-15).

It would have been obvious to one of ordinary skill in the art to incorporate such user specific protocols, as disclosed in Baudoin, within the lookup table of Shafer in order to obtain the predictable result of enabling the system to determine the appropriate protocol that emails should be formatted in order for the recipients to be able to properly receive and read their email.

The combined teachings of Shafer and Baudoin did not explicitly state wherein the record includes:

an availability field, wherein the availability field is a status indication of whether a display capability is currently available to receive email or to display digital objects included in email, including indicating whether a client device or display device is powered off or on.

Wakabayashi disclosed a monitoring apparatus that stores a monitored terminal information table which includes fields such as name, IP address, Mail address, Notifying Mail address, and Notification status, in which the notification status includes

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values that indicate whether the receiving device is powered on or off (Wakabayashi, Fig. 3, [0035]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the availability field, as well as all the others, of Wakabayashi into the combined teachings of Shafer and Baudoin in order to achieve the predictable result which is for the system to be able to determine whether the receiving machine is currently in a state that allows for it to receive email addressed to it

The combined teachings of Shafer, Baudoin, and Wakabayashi did not explicitly state wherein the record includes a recent usage field, wherein the recent usage field is a status indication of a recent time when a capability was used.

In an analogous art, Albal disclosed a system and method for creating an email usage record every time a user sends an email, in which the email usage record includes the capabilities used in sending the email as well as the time the email was sent (Fig. 2, 100, col. 2, lines 55-67, col. 3, lines 19-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Albal's disclosed fields within the email usage record within the table of the Shafer, Baudoin, and Wakabayashi combination in order to keep track of user specifics as far as using their email, and to be able to determine what capabilities the user is mostly interested in using, thereby sending email with the capabilities that they most desire to use out of all possible capabilities.

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4. Regarding Claims 4, 11 & 18, Shaffer, Baudoin, Wakabayashi, and Albal disclosed the limitations as described in claims 1, 9, and 15. Shafer further disclosed:

- receiving an email in a transcoding gateway, the email comprising an email address and at least one digital object, (Claims 1-20);
- determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, wherein the determining results in a determination, (Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38);
- forwarding the email, including the digital object, to the email address, if the determination is that the digital object is not to be transcoded in the transcoding gateway, (Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38); and
- if the determination is that the digital object is to be transcoded in the transcoding gateway, carrying out the further steps of transcoding the digital object into a transcoded digital object; and downloading the transcoded digital object to a destination client device, (Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38).

3. Regarding Claims 5, 12 & 19, Shaffer, Baudoin, Wakabayashi, and Albal disclosed the limitations as described in claims 4, 11 & 18. Shaffer further discloses:

- transcoding the digital object further comprises transcoding the digital object into a digital file having a digital format and a file name, (Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38); and

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- downloading the transcoded digital object further comprises downloading the digital file to a destination client device at an internet address recorded in an Internet address field of a client device record, the client device record having recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65; Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38), (Examiner notes that Shaffer clearly teaches a message server with a universal register/lookup table/database and access control/user verification functionality, wherein an email address generally clearly and obviously reads upon an Internet address having a mailbox address identical to an email address); and
- recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65; Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38), (Examiner notes that Shaffer clearly teaches an access capability determination as well as multimedia attachments which are well-known to be digital in format, (Col. 1, lines 16-23).

4. Regarding Claims 6, 13 & 20, Shaffer, Baudoin, Wakabayashi, and Albal disclosed the limitations as described in claims 4, 11 & 18. Shaffer further discloses wherein determining in dependence upon display capability attributes and the email

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address, whether the digital object is to be transcoded in the transcoding gateway, further comprises finding a capability record having a connection address equal to the email address, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65; Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38). Thus, Claims 6, 13 & 20 are found to be unpatentable over considerable consideration of the teachings of Shaffer.

5. Regarding Claims 7, 14 & 21, Shaffer, Baudoin, Wakabayashi, and Albal disclosed the limitations as described in claims 4, 11 & 18. Shaffer further discloses wherein forwarding the email further comprises forwarding the entire email, including the digital object, to an email client in another transcoding gateway in a client device, (Col. 2, lines 30-67; Col. 3; Col. 4, lines 1-65; Col. 5, lines 65-67; Col. 6; & Col. 7, lines 1-38). Thus, Claims 7, 14 & 21 are found to be unpatentable over considerable consideration of the teachings of Shaffer.

8. Claims 2, 3, 9, 10, 16 & 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer, Baudoin, Wakabayashi, and Albal and in further view of Schwalm et al. (U.S. Patent Number 5,339,361).

6. Regarding Claims 2, 9 & 16, Shaffer, Baudoin, Wakabayashi, and Albal disclosed the limitations as described in claims 1, 9, and 15. Though the combined teachings of Shaffer, Baudoin, Wakabayashi, and Albal discloses an email administration system inclusive of access control, (Shaffer – Col. 1, lines 58-62), Shaffer, Baudoin,

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Wakabayashi, and Albal do not specifically disclose wherein the email display capability status request includes a sender identification identifying the sender, and the method further comprises determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain. Schwalm specifically teaches a sender verification functionality, (Schwalm – Abstract & Fig. 2), wherein it would have been obvious to incorporate a sender verification means into the Shaffer system for purposes of providing controlled access and transmission/receipt confirmation by authorized parties, (Schwalm – Col. 1, lines 14-52), within an email system which already requires user verification like that of Shaffer, and wherein it would have been obvious to augment the Shaffer controlled access means by implementing sender verification as well. Thus, Claims 2, 9 & 16 are found to be unpatentable over considerable consideration of the teachings of Shaffer, Baudoin, Wakabayashi, Albal and Schwalm.

10. Regarding Claims 3, 10 & 17, Shaffer, Baudoin, Wakabayashi, Albal and Schwalm are relied upon for those teachings noted herein. Schwalm further discloses wherein determining that the sender is authorized to send email to a connection address in the domain further comprises sending in dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record, (Col. 1, lines 14-67; Col. 2, lines 1-15; & Claims 1-23), wherein:

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- the sender authorization record represents authorization for the sender to send email to a connection address in the domain, (Col. 1, lines 14-67; Col. 2, lines 1-15; & Claims 1-23);
- the sender authorization record comprises sender authorization attributes including a connection address in the domain, (Col. 1, lines 14-67; Col. 2, lines 1-15; & Claims 1-23), (Examiner notes that in light of Shaffer, the sender record obviously includes connection addresses of those domains where the sender is authorized to transmit data/email for purposes of transmission verification); and
- finding at least one email display capability record for the domain further comprises finding in dependence upon the domain identification and in dependence upon the connection address, at least one email display capability status record for the domain, (Schwalm - Col. 1, lines 14-67; Col. 2, lines 1-15; & Claims 1-23), (Shaffer - Col. 6, lines 6-67 & Col. 7, lines 1-38), (Examiner again notes that Shaffer discloses wherein if an attachment does not need conversion, it is transmitted to the client/target. Moreover, Shaffer teaches a checking, determining and converting process, wherein the client does not intervene with the same, and wherein the client/target email display capability status attributes are determinative of the need for sender notification and/or conversion).

Thus, Claims 3, 10 & 17 are found to be unpatentable over considerable consideration of the teachings of Shaffer and Schwalm.

Response to Arguments

Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure

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relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jerry Dennison/
Examiner, Art Unit 2143